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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,102	06/20/2000	Christopher Graham Raphael Parsons	MERZ30 / dln	6038

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EXAMINER	
JIANG, SHAOJIA A	
ART UNIT	PAPER NUMBER
1617	8

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/597,102	PARSONS ET AL.	
	Examiner	Art Unit	
	Shaojia A. Jiang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 March 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *7* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on March 12, 2002 in Paper No. 6 wherein claims 18-24 are cancelled and claim 1 has been amended. Currently, claims 1-17 are pending in this application.

Applicant's remarks filed on March 12, 2002 in Paper No. 6 with respect to the rejection of claims 12-13 made under 35 U.S.C. 112 second paragraph for the insufficient antecedent basis for this limitation in the claim, of record stated in the Office Action dated September 6, 2001 have been fully considered and found persuasive to remove the rejection of claims 12-13.

Applicant's amendment (canceling claims 18-24) filed on March 12, 2002 in Paper No. 6 with respect to the rejections of claims 18-24 made under 35 U.S.C. 112 second paragraph and under 35 U.S.C. 101 for the claimed recitation of a use in claims 18-24 has been fully considered and found persuasive to remove the rejection. Therefore, the said rejection is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Gold et al. (WO 99/01416) for reasons of record stated in the Office Action dated September 6, 2001.

Applicant's remarks filed on March 12, 2002 in Paper No. 6 with respect to this rejection of claims 1-24 made under 35 U.S.C. 102(b) of record stated in the previous Office Action dated September 6, 2001 have been fully considered but they are not deemed persuasive to render the claimed invention patentable over the prior art for the following reasons.

Applicant asserts that "many of the diseases contemplated to be treated are under intensive research to clearly define the exact mechanism of action involved in their etiology", by employing the same compounds. Applicant's arguments are not found persuasive since the claiming of a new use, new function or unknown property which is inherently present in the prior art method will not make the claim patentable. See *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). As discussed in the 102(b) rejection in the previous Office Action, Gold's method employing the same compounds in the same active amounts to be administered in treating a living animal for alleviation of a condition which is alleviated by an NMDA receptor antagonist inherently treats the same living animal for inhibition of progression or alleviation of a condition which is alleviated by a 5HT3 or neuronal nicotinic receptor antagonist, as claimed herein, since Gold's method steps are same as the instant method steps. See *Ex parte Novitski*, 26 USPQ 2d 1389. See also MPEP § 2112.01 with regard to inherency as it related to the claimed invention herein.

Moreover, the mechanism of action of a treatment does not have a bearing on the patentability of the invention if the method steps are already known even though applicant has proposed or claimed the mechanism. Applicant's recitation of a new mechanism of action for the prior art method will not, by itself, distinguish the instant claims over the prior art teaching the same or nearly the same method steps. Mere recognition of latent properties in the prior art does not render novel or nonobvious an otherwise known invention. See *In re Wiseman*, 201 USPQ 658 (CCPA 1979).

Thus, Gold anticipates the claimed invention.

In view of the rejections to the pending claims set forth above, no claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

Shaojia A. Jiang, Ph.D.
Patent Examiner, AU 1617
May 21, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200